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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,607	09/22/2003	Satoshi Suda	09868/000M896-US0	9764

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EXAMINER	
MOSSER, ROBERT E	

ART UNIT	PAPER NUMBER
3714	

MAIL DATE	DELIVERY MODE
12/01/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/667,607	SUDA ET AL.	
	Examiner	Art Unit	
	ROBERT MOSSER	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 September 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-11,14-20 and 22-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6-11,14-20 and 22-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *9/22/2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/24/2009*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 24th, 2009 has been entered.

Information Disclosure Statement

The information disclosure statement entered September 24th, 2009 has been considered. A copy of the cited statement(s) including the notation indicating its respective consideration is attached for the Applicant's records.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims **1-4, 6-11, 14-20,** and **22-24** are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the substitution of a wild symbol for the particular symbol forming a winning combination, does not reasonably provide enablement for the "morphing" wild symbol. The specification does not enable any

person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

In particular the term morph denotes a transformation of the symbol from one state or thing into another yet the specification fails to describe this process in discussing a substitution of the particular symbol for a wild symbol. There is no language present in the specification as originally presented that would otherwise indicate that the applicant's substitution would otherwise incorporate a transformation required to link the disclosed substitution to a morphing of symbols as claimed. Appropriate correction is required.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the morphing of the wild symbol into the particular symbol and vise versa as claimed must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1-4, 6, 8-11, 18-20, 22,** and **24** are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Bennett (US 6,419,579) in view of Inoue (US 6,942,572), in further view of Yoseloff (US 6,311,976) in yet further view of Kaminkow (US 6,837,790).

Claims **1-2, 4, 6, 8, 10-11, 18, 20, 22,** and **24**: Bennett teaches a gaming machine comprising:

a display module with multiple display areas contained therein for displaying a changing display including the changing of multiple symbols (reel spin feature) at the start of a game (*Bennett* Figure 1, Col 1:60-67);

a plurality of symbols including at least one wild symbol (*Bennett* Fig 3, Col 2:1-21);

multiple win lines comprising a subset of the plurality of symbols (*Bennett* Col 3:25-35);

a static display of the plurality symbols on multiple areas of the display module (*Bennett* Figure 1, Col 1:60-67); and

an evaluation module for identifying multiple winning arrangements of symbols and wild symbols on the display such that the wild symbol establishes multiple predefined wins (*Bennett* Figure 1, Col 4:29-5:25).

While Bennett is arguably silent regarding visually differentiating the winning combinations generated on the display, the related invention of Inoue teaches the visual differentiation of winning combinations through the use of different colors of Illumination in a gaming machine (*Inoue* Abstract Col 2:5-24, 8:1-11). It would have been obvious to

one of ordinary skill in the art at the time of invention to have incorporated the differentiation features of Inoue into the invention of Bennett in order to clearly present the winning game results to the player thereby preventing confusion as taught by Inoue (*Inoue* Col 2:5-36)

The combination of Bennett & Inoue is silent regarding the utilization of a time interval to change a wild symbol present in a winning combination to other specific symbols that complete the winning arrangement however the related invention of Yoseloff teaches the morphing (a process understood to inherently include transformation over a time interval) of a wild symbol into a specific game symbol as to complete a winning combination (*Yoseloff* Col 8:44-46, 10:21-29, 11:22-37). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the wild symbol morphing features of Yoseloff into the combination of Bennett and Inoue in order to clearly present to the player the specific game symbol that the wild symbol is substituting.

Though the combination of Bennett, Inoue, and Yoseloff teaches the gaming device as set forth above, the combination is silent regarding the incorporation of a vibration feature such that a display mechanism vibrates when a multiple win feature including a common wild symbol occurs. In a related invention however, Kaminkow teaches the inclusion of a vibration feature for vibrating displayed game elements in an electronic wager game wherein the feature is further taught by Kaminkow as being readily adaptable to a plurality game trigger events (*Kaminkow* Col 2:16-37, 5:25-32). It would have been obvious to one of ordinary skill in the art at the time of invention to

have incorporated the features of the vibration feature as taught by Kaminkow into the invention of Bennett, Inoue, and Yoseloff in order to provide the player with additional entertainment and excitement as taught by Kaminkow (*Kaminkow* Col 2:54-60). Claim language extending the vibration of game elements to a plurality of game symbols is understood as encompassed by the teachings of Kaminkow and in the alternative thereto representing an obvious duplication of parts (per MPEP 2144.04.VI.B) of Kaminkow in the combination of Bennett, Inoue, Yoseloff & Kaminkow that would have been obvious to one of ordinary skill in the art at the time of invention to draw attention to the morphing transformation taking place and the additional payouts formed though the morphing of the game symbols provided by Yoseloff and Inoue in the combination of Bennett, Inoue, Yoseloff & Kaminkow.

Claim **3, 9,** and **19**: In addition to the presentation of Yoseloff as presented above Bennett teaches the sequential displaying of multiple winning arrangements with a changing wild symbol, in which multiple wins are established (*Bennett* Col 4:29-5:25).

Claims **7, 14-17,** and **23** are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Bennett (US 6,419,579) in view of Inoue (US 6,942,572), in further view of Yoseloff (US 6,311,976) in yet further view of Kaminkow (US 6,837,790) in still yet further view of Hamano (US 5,205,555).

Though teaching teaches the gaming device as set forth above, the combination of Bennett, Inoue, Yoseloff, and Kaminkow is silent regarding the incorporation of

multiplier that are predetermined based on the symbol combination. In a related invention however, Hamano teaches the inclusion of predefined multipliers in a multi-reel slot machine (Figures 15-16, Col 1:38-2:39) to make a slot machine game more entertaining and a more exciting experience. It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the predefined multiplier of Hamano into the combination of Bennett, Inoue, Yoseloff, and Kaminkow in order to make a slot machine game more entertaining and a more exciting experience as taught by Hamano.

Response to Arguments

Applicant's arguments with respect to claims **1-4, 6-11, 14-20,** and **22-24** have been considered but are not persuasive.

On pages 11 and 12 of the applicant's remarks dated September 17th, 2009 argue that the prior art of Kaminkow broadly teaches the use of the simulated vibration feature across an entire display screen or limited portions thereof while the applicant's claimed invention limits the use of the simulated vibration feature to particular symbols, portions thereof while the wild symbol is morphed into the particular symbol. The applicant further presented within the same pages that Kaminkow (by the applicant's remarks) should only be interpreted to include either the use of the vibration of a complete displayed image or only fixed portions thereof where as the applicant's use of

the vibration feature is tied to portions or groupings of symbols tied to the plurality of symbols.

In response to applicant's arguments against the Kaminkow reference individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant's remarks do not address the teachings of the combination of references with regards to the limiting of visual effects (i.e. vibration, morphing, paylines), consideration and redress of the teachings of Kaminkow. As the rejection of record is based on the combination of Bennett, Inoue, Yoseloff, and Kaminkow applicant's challenges regarding the limiting of the vibration feature are incomplete because they are silent with regards to the remaining references and the teachings contained therein with at least regards to the limiting of visual effects to limited set of the displayed plurality of game symbols.

Additional the applicant's claim amendments have raised issues with regards to scope of enablement and deficiencies of the presented drawings reflective of the same.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT MOSSER whose telephone number is (571)272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry Suhol/
Supervisory Patent Examiner, Art Unit 3714

/R. M./
Examiner, Art Unit 3714